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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,287	12/12/2001	Michael Black	RLT-111/US	1768

7590 10/20/2003

COOLEY GODWARD LLP
ATTN: PATENT GROUP
ONE FREEDOM SQUARE
RESTON TOWN CENTER 11951 FREEDOM DRIVE
RESTON, VA 20190-5601

EXAMINER	
SHAY, DAVID M	
ART UNIT	**PAPER NUMBER**
3739	9

DATE MAILED: 10/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

N.K.

Office Action Summary

Application No.	Applicant(s)
10/017,287	Black
Examiner	**Group Art Unit**
d. shay	3739

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Peri d for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☑ Responsive to communication(s) filed on December 12, 2001; March 6, 2002.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disp sition of Claims

☐ Claim(s) 1-68 is/are pending in the application.

Of the above claim(s)_____ is/are withdrawn from consideration.

☐ Claim(s)_____ is/are allowed.

☑ Claim(s) 1-68 is/are rejected.

☐ Claim(s)_____ is/are objected to.

☐ Claim(s)_____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on_____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on_____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Pri rity under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number)_____.

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received:_____.

Attachment(s)

☑ Information Disclosur Statem nt(s), PTO-1449, Paper No(s). 4&5

☐ Interview Summary, PTO-413

☑ Notice of References Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Revi w, PTO-948

☐ Oth r_____

Office Action Summary

The attempt to incorporate subject matter into this application by reference to the co-pending application cited on page 1 is improper because the application is not identified by serial number and filing date.

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 57-68 are rejected under 35 U.S.C. 101 because the claims are directed to a computer program per se (claims 57-64) and a collection of data per se (claims 65-68).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10, 11, 15-17, 19, 24, 30-44, 50, 51, and 53 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 11 exactly what the term "flashlight laser" is intended to refer to is unclear. In claims 15 and 37 "said mirror based optical delivery device" lacks positive antecedent basis and claims 14 and 36 appear to be substantial duplicates of claims 15 and 37 respectively. In claims 16, 17, 19, 38, 39, 41, 50, 51,and 53 there is no function positively associated with the claimed means and as such it is unclear what further limitation is intended to be recited thereby. In claim 24 it is unclear what further structure is intended to be inferred by reciting the material onto which the light is directed. Claim 30 is indefinite as what is to be encompassed by the term "independent power", the term is unclear in that power from e.g. an electrical outlet could be considered power independent of batteries. Claim 31 is incomplete as no lasers are positively

claimed. In claims 10 and 34 it is unclear what further limitation is intended to be claimed, as selecting or controlling the beams having certain parameters already requires that the beams be controlled to have these certain parameters. Claim 42 is indefinite as it is unclear what further structure is intended to be implied thereby, as claim 31 already requires the production of a combined treatment beam.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6, 8-12, 24-26, 28, 30-34, 42, 43, 45-48, 54, and 55 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Dumoulin – White et al.

See figure 4; column 3, line 37 to column 5, line 49; and column 6, line 49 to column 7, line 61.

Claims 1-8, 10-17, 19, 24, 25, 28, 30-39, 41, 42, 45-51, 53 and 54 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Freiberg.

See Figures 1 and 9; column 1, line 38 to column 2, line 52, and column 3 line 37 to column 6 line 58.

Claims 1-13, 20, 21, 24, 25, 30-35, 38, 39, 42, 45-51,and 54 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Sugiyama et al.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 18, 28, 29, 31, 40, 45, and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freiberg in combination with Black et al ('936). Freiberg teaches a device such as claimed, except the micromanipulator. Black et al ('936) teach the use of a micromanipulator as an input device for an endoscope. It would have been obvious to the artisan of ordinary skill to employ the micromanipulator of Black et al ('936) in the device of Freiberg, since this is an appropriate control device for an endoscope, as taught by Black et al ('936) or to include the beam combiner of Freiberg in the device of Black et al ('936), since this allows multiple treatments with a single instrument as taught by Freiberg and to construct the device in the claimed dimensions, since this would render the device such as claimed.

Claims 1, 20, 22, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freiberg in combination with Dew. Freiberg teaches a device as claimed. Dew teaches removing optical components from the optical path by rendering the location that the optical component resides in no longer a part of the optical path. It would have been obvious to the artisan of ordinary skill to employ the optical path combining device of Dew in the device of Freiberg, since Freiberg discloses no particular mechanism to accomplish to superposition of beams, thus producing a device such as claimed.

Claims 1, 26, 27, 31, 43, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freiberg in combination with Kittrell et al. Freiberg teaches a device and

method such as claimed. Kittrell et al teach an apparatus for and method of the use of fluorescence maps for diagnosing tissue to locate tissue that is suitable for removal. It would have been obvious to the artisan of ordinary skill to employ the diagnostic system of Kittrell et al in the system of Freiberg since this can locate the tissue requiring treatment and prevent the treatment of healthy tissue as taught by Kittrell et al or to include the multiple laser system of Freiberg in the device of Kittrell et al, since this would allow treatment of both hard and soft tissue, as taught by Freiberg, thus producing a device such as claimed.

Claims 45, 55, and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freiberg in combination with Kittrell et al. The teachings of Kittrell et al and Freiberg and the motivations for combination thereof are as essentially those set forth above. It would have been obvious to the artisan of ordinary skill to combine these old and well known teachings to produce a device such as claimed.

Any inquiry concerning this communication should be directed to David Shay at telephone number 308-2215.

Shay/Dl
October 2, 2003

DAVID M. SHAY
PRIMARY EXAMINER
GROUP 330